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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/952,001    11/07/97    CARR

R    P97194.024

EXAMINER

PM82/0409

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SUITE 1925  
PORTLAND OR 97204

PICKARD, A

ART UNIT

PAPER NUMBER

3626

DATE MAILED:

04/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/952,001**

Applicant(s)

**Carr**

Examiner

**Allison Pickard**

Group Art Unit

**3626**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 55-92 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 56-58 and 88-92 is/are allowed.

☒ Claim(s) 55, 60-62, 66-69, 73-78, 82-85, and 87 is/are rejected.

☒ Claim(s) 59, 63-65, 70-72, 79-81, and 86 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States..

2. Claim 55 is rejected under 35 U.S.C. 102(b) as being anticipated by Merwarth, U. S.

Patent No. 605,891.

Merwarth discloses a gasket similar to applicant's comprising a first strip c, a second strip c<sup>3</sup>, and at least one spoke c<sup>2</sup>. The first and second strips and the spokes are formed of a material adapted for sealing. Strips c and c<sup>3</sup> are made of soft metal (page 2, lines 25-30) and c<sup>2</sup> is made of soft metal (page 2, line 46).

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 60-62, 66-69, 73-78, and 82-84 rejected under 35 U.S.C. 103(a) as being

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unpatentable over Mastin, U. S. Patent No. 1,245,002 in view of Smith, U. S. Patent No. 4,002,344.

Mastin discloses a gasket similar to applicant's comprising a first strip g', a second strip j, and at least one spoke k of sealing material (see Figure 3). A third strip (the inner most loop g') having an outer periphery less than the inner periphery of the first strip and a spoke extending between the third and first strips g' can be seen in Figure 3 as well. The strips and spokes are formed of the same sealing material and "are designed to produce a hermetic seal" (page 1, lines 23-27). Mastin does not disclose open or closed alignment spokes extending from the second strip.

Smith teaches the use of an open 46 and closed 51 alignment spoke which center a gasket between a variety of different sized flanges. The open spoke defines a concavity 48 and centering shelf 49. The closed spoke 51 has an aperture for a bolt and a tab portion 56 with identification data. These locators, 46 and 51, are taught to "accommodate different flange sizes, bolt circles, and bolt diameters" (col. 1, lines 35-37). Therefore, flanges with different outer peripheries could be used so that the locator or alignment spoke is congruent with a larger outer flange while the outer or second strip is congruent with a smaller outer flange. As for making the alignment spokes out of the sealing material used for the strips and spokes, Mastin discloses using the ribs or ridges (spokes or strips) around openings to produce a hermetic seal. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to include an open or closed alignment spoke as taught by Smith extending from the second strip

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out of the sealing material to provide a gasket which can be properly aligned between a variety of different sized flanges which would provide an efficient seal at the inner and outer edges of the flanges as well as around the bolt holes.

5. Claim 85 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mastin.

Mastin discloses a gasket similar to applicant's comprising a first and second strip and at least one spoke. However, Mastin's outer or second strip is not formed in a square shape. Using a square shape is considered a design choice as applicant has not stated that using a square rather than a circle solves any stated problem or is for any particular purpose. Further, it appears that the circular shape of Mastin would perform equally as well. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to form the second strip with a square shape as a matter of choice in design.

6. Claim 87 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mastin as applied to claim 85 above, and further in view of Smith.

As mentioned above, Mastin does not include a closed alignment spoke which can receive a bolt. Smith teaches the use of a closed 51 alignment spoke to center a gasket between a variety of different sized flanges. The closed spoke 51 has an aperture for a bolt. The closed spoke 51 is taught to "accommodate different flange sizes, bolt circles, and bolt diameters" (col. 1, lines 35-37). As for making the alignment spokes out of the sealing material used for the strips and spokes, Mastin has disclosed that this is desirable so as to provide a seal around the holes. Therefore, it would have been obvious for one of ordinary skill in the art at the time the

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invention was made to include a closed alignment spoke as taught by Smith extending from the second strip out of the sealing material to provide a gasket which can be properly aligned between a variety of different sized flanges which would provide an efficient seal at the inner and outer edges of the flanges as well as around the bolt holes.

***Allowable Subject Matter***

7. Claims 56-58 and 88-92 are allowed.
8. Claims 59, 63-65, 70-72, 79-81, and 86 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments filed 1-31-01 have been fully considered but they are not persuasive.

Merwarth discloses a gasket comprising a first strip, second strip, and at least one spoke extending therebetween. The strips and spokes are made of a soft metal. There is nothing in the disclosure to indicate the soft metal of the strips is not the same soft metal of the spokes.

Applicant's argument that the soft metal of the strip is different from that of the spokes goes beyond the disclosure of the reference. Merwarth discloses first and second strips made of a soft metal to provide an "efficient seal" at the inner and outer edges of the pipe sections (page 2, lines 32-35). Merwarth discloses that a suitable soft metal for use is copper (page 2, lines 5-6). Merwarth discloses at least one spoke formed of a soft metal. Merwarth discloses that the spokes

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can be made the same size as the inner and outer loops “to form a seal around” the holes in the flanges (page 2, lines 45-50). Since there is no disclosure which indicates the soft metal of the loops is different than that of the spokes, it is considered inherent that they are the same, especially since the loops and spokes provide a seal at their locations. What would lead one to choose two separate materials to provide the same function?

In response to applicant's argument that the locator of Smith is not used to form a seal and therefore there is no motivation to form the locator of the same sealing material as the rings, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Smith provides motivation to use an alignment spoke (open or closed) for locating. Mastin already discloses using sealing material around openings to produce a seal. Therefore, combining the teaching of locating (from Smith) with the gasket taught by Mastin would produce applicant's invention as claimed.

Regarding claim 85, making the outer loop square is considered a design choice. Applicant has argued the square would have a mechanical function of centering on a circular pipe flange. However, these features are not claimed. Furthermore, a square loop would only provide applicant's proposed benefits on a circular flange of appropriate size. A square loop on a flange

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with a substantially larger outer periphery would not serve to center any better than a circular loop.

*Conclusion*


10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison Pickard whose telephone number is (703) 305-0882.

AP

April 8, 2001



Anthony Knight  
Supervisory Patent Examiner  
Group 800